

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
CER-001

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Application Number
10/585,011

Filed
June 29, 2006

on _____

Signature _____

Typed or printed
name _____

First Named Inventor
Egner et al.

Art Unit
3695

Examiner
Baird, Edward J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 37,793

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____



Signature

Brian A. Carlson

Typed or printed name

972-732-1001

Telephone number

8/10/11

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 form is submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Egner et al.	Docket No.:	CER-001
Serial No.:	10/585,011	Art Unit:	3695
Filed:	June 29, 2006	Examiner:	Baird, Edward J.
For:	System and Method for Analyzing Strategic Network Investments in Wireless Networks		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sirs:

Claims 1-10, 22-31, 43, 44 and 53-58 have been rejected under grounds that are clearly in error and, as a result, this case is appropriate for the pre-appeal brief review procedure. In particular, independent claims 1 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adduci et al., U.S. Patent No. 7,343,334 ("Adduci") in view of Cossins et al., U.S. Publication No. 2003/0083073 ("Cossins") and Elliot, U.S. Patent No. 7,158,790 ("Elliot"). See Office Action, p. 5 (May 10, 2011).

1. Applicant's independent claims recite claim elements not taught by the cited art

Independent claims 1 and 22 recite "determining . . . an investment return per sector for the first sector and each of the one or more other sectors in the wireless network," and selecting/identifying "one of the sectors in the wireless network for capital investment." Adduci, Cossins and Elliot, taken alone or in combination, do not teach or suggest determining an investment return per sector for multiple sectors in a wireless network.

Cossins and Elliot do not disclose, and the Examiner has not asserted that Cossins and Elliot disclose, determining an investment return per sector for multiple sectors in a wireless network. Applicant therefore concentrates on Adduci in the discussion below.

2. *Summary of Applicant/Examiner discussions of the “per sector” claim elements*

One of the primary disagreements between Applicant and Examiner is the scope of the claim elements operating on a sector-by-sector basis, and in particular the claim element “determining . . . an investment return per sector for the first sector and each of the one or more other sectors in the wireless network.” To provide a brief history, the Examiner initially noted “that the statement of ‘determining an investment return per sector for one or more of the sectors’ (emphasis added) as recited in claim 1 is merely a statement of intended use.” Office Action, p. 5 (Jan. 28, 2010). Applicant traversed and responded by amending the claims to recite “the wireless network comprising multiple cell sites, each cell site having a coverage area divided into sectors, each sector having at least one cell site antenna serving that sector, the wireless network thereby comprising multiple sectors,” thus clarifying that the meaning of “sector” in the claims is the plain and ordinary meaning of the term as it is widely used in the wireless telecommunications industry. *See* Supplemental Amendment, pp. 2, 5 (May 11, 2010).

The Examiner responded to Applicant’s amendment by stating “that the ‘determining an investment return per sector for one or more of the sectors’ is functionally equivalent to ‘determining an investment return’ for anything.” Office Action, p. 3 (Aug. 3, 2010) (emphasis added). Applicant then traversed and amended the claims to recite “determining . . . an investment return per sector for the first sector and each of the one or more other sectors in the wireless network,” thus ensuring that the claims clearly recite determining a separate investment return for each individual sector. *See* Amendment, pp. 3, 7 (Oct. 27, 2010).

The Examiner responded to Applicant’s amendment by stating “Examiner notes that Applicant is merely repeating steps which does not add patentable weight.” Office Action, p. 4 (Jan. 6, 2011). Applicant again traversed and asked an expert in telecommunications, Dr. Charles

Bernardin, to submit a declaration to explain the meaning of the term “sector” as understood by one of ordinary skill in the art, and to discuss the differences between such a sector and Adduci’s service-level geographic region. *See* Declaration of Dr. Charles Bernardin filed under 37 C.F.R. § 1.132 (Mar. 28, 2011) (“Bernardin Declaration”).

The Examiner responded with the currently pending Office Action, stating that evaluating individual sectors “is merely a statement of intended use,” that Applicant’s argument “is unclear in reference to sector sizes,” and that “based on the broadest reasonable interpretation of the term ‘sector’, a sector can include a particular geographic region such as a country or a portion thereof.” Office Action, pp. 3-4 (May 10, 2010).

3. ***The claim limitation “determining . . . an investment return per sector for the first sector and each of the one or more other sectors in the wireless network” is an affirmative limitation, and is not merely an intended use***

Applicant asserts that the Examiner’s position on “intended use” for the “per sector” claim limitations is factually and legally wrong. In particular, the claim element “determining an investment return per sector for the first sector and each of the one or more other sectors in the wireless network” is an affirmative limitation, not an intended use. “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” M.P.E.P. § 2106 (II) (C). Applicant’s “per sector” claim limitation clearly is not suggestive or optional. To the contrary, it limits the scope of the claims by requiring a specific and concrete step that must be performed for each of the claimed sectors. *See id.* at § 2111.04. That is, in “determining . . . an investment return per sector,” the operation on each “sector” is part of the execution of the step itself, not an intended result of the step. Examiner’s “intended use” arguments appear better suited for recitations in a claim preamble, not affirmative steps in the claim body. *See id.* at § 2111.02 (II).

Furthermore, “USPTO personnel must always remember to use the perspective of one of ordinary skill in the art.” *See id.* at § 2106 (II) (C). As Dr. Bernardin makes clear,

The term “sector” in a cellular network has a known meaning to those of ordinary skill in the art in the field of wireless telecommunications. A sector in a cellular network is known as the physical area covered by a directional antenna at a base station site (note that there may be other directional antennas covering the same area, such as when there are separate antennas for transmit, receive and control). For example, Egner shows fifteen sectors C101-C115 in Figure 1, and fifteen sectors C201-C215 in Figure 2, with each sector covering a 120° area centered at its respective base station site location. A geographic region as disclosed by Adduci includes many such sectors so as to provide service coverage for the country, city, or metropolitan area (as stated in the first two full sentences of column 6 in Adduci).

Bernardin Declaration at ¶ 9. Accordingly, the term “sector” recited in Applicant’s claims has a well-known and specific meaning to one of ordinary skill in art. And as explained below, the “per sector” language is material to patentability; therefore it cannot be ignored by the Examiner in order to change the substance of the claim. *See* M.P.E.P. § 2111.04. Accordingly, Applicant respectfully asserts that the “per sector” limitations must be taken into consideration when interpreting Applicant’s claims and comparing them to the cited art.

4. *Applicant’s claims are directed to evaluating capital investment in individual wireless network sectors, while Adduci is directed to evaluating investment of wireless services for an entire geographic region*

Applicant’s claims require determining an investment return per sector for a first and one or more other sectors in a wireless network, and selecting/identifying one of the sectors in the wireless network for capital investment. That is, an investment return is determined separately for each of the first and one or more other sectors in the wireless network.

Adduci, in contrast, discloses a financial analysis method related to “the provision of enhanced wireless communications services. The method includes accepting user input related to an existing wireless communications service and a proposed enhanced wireless communications

service.” Adduci, Abstract. Such enhanced wireless services include GPRS and UMTS. *See id.* at col. 2:14-18. As is well known in the art, enhanced wireless communications services are provided and made to function over an entire geographic region containing many wireless network sectors, and are not implemented on an individual sector basis. Adduci further explains that a “particular geographic region may represent a country or a portion thereof. For example, a particular geographic region may represent a city or a metropolitan area.” *Id.* at col. 6:3-6.

In the wireless telecommunications industry, when a particular service is deployed, it is deployed to all sectors in a geographic region, such as a country, city or metropolitan area. In my professional judgment, one of ordinary skill in the art would never deploy a service, such as UMTS, in one sector of a three-sector site without deploying it in the other two sectors of the site, let alone without deploying it in the rest of the sectors in the geographic region.

Bernardin Declaration at ¶ 10. In Dr. Bernardin’s professional judgment, “Adduci does not provide any motivation to one of ordinary skill in the art to perform investment evaluation of either a service or capital equipment on a per sector basis in a cellular network.” *Id.*

5. Conclusion

In view of the above, Applicant respectfully asserts that independent claims 1 and 22 are patentable over Adduci, Cossins and Elliot. Further, the dependent claims are allowable by depending from allowable claims as well as for adding new limitations. Applicant therefore respectfully requests that the final rejection be withdrawn and the application passed to issuance.

Respectfully submitted,

August 10, 2011

Date

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